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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,792	01/10/2005	Aldo Di Nicolantonio	3165	3246

7590  
Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

09/14/2007

EXAMINER
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LEE, LAURA MICHELLE

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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09/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/520,792

Applicant(s)

DI NICOLANTONIO, ALDO

Examiner

Laura M. Lee

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 2 and 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see the first paragraph of pages 3 and 4, filed 6/15/2007, with respect to the rejection(s) of claim(s) 1-10 under Stiltz and Pfanzer have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Dravnicks (U.S. Patent 5,099,705).

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

Claim 1, line 4, it is suggested to change the limitation "which is oriented lateral to the longitudinal motion, to the saw blade", to -- which is oriented transverse to the longitudinal axis of the saw blade-- to more clearly distinguish the orientation of the stroke direction.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3,4,9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, recites "wherein the oscillation mechanism includes a spring element (53) that is disposed between the housing (2) and the end (52) of the roller lever (5)." However, the specification, (page 2, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs), states that "... the forward progress of the saw changes automatically by means of an adaptive, automatic oscillation that is a function of the advancing force in the cutting direction. Preferably, this occurs by means of a spring element that is compressed further as the advancing force, i.e. cutting speed, increases." Therefore, if the spring element (53) is a structure of the "means... for automatically adjusting the oscillation stroke..." it cannot also be claimed as a part of the oscillation mechanism, wherein the duality of the oscillation mechanism and the "means... for" was previously identified in claim 1.

Claim 9, further recites "wherein the saw blade is pressed against the roller by a compression sprig (30) whose compression spring force (F2) is weaker than a spring force (F1) of a spring element (53). First, as it appears from the discussion above, that the applicant has disclosed that the spring element (53) is apart of the "means... for automatically adjusting the oscillation stroke," it therefore cannot be separately claimed without establishing that the spring element is apart of the "means... for." Otherwise, the applicant is improperly claiming the same structure twice. Secondly, it appears from the specification (page 2, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs), that the applicant also considers the spring forces acting on the blade in addition to spring element (53) to be apart of the "means... for automatically adjusting the oscillation stroke." Similarly, these spring forces also cannot be recited without establishing that the spring forces are apart of the "means... for." Otherwise, the applicant is improperly claiming the same structure twice.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dravnicks (U.S. Patent 5,099,705). Dravnicks discloses a motor (62) driven compass saw (Figure 13) having a housing (60) that contains a longitudinally moving lifter rod (74), which supports a saw blade (2), and an oscillation mechanism (67/68/70) that is able to impart a variable oscillation stroke (to a counterweight, 76), which is oriented lateral to the longitudinal motion (which has a component of motion orientated lateral to the longitudinal motion; see Figures 17/18) to the saw blade (2), wherein means (spring, 78; pivot levers 83 and 83a) is provided for automatically adjusting the oscillation stroke smoothly between the maximum and minimum stroke during the sawing process, as an automatic response to a function of the pressure of the saw blade against a work piece to be sawn (see column 9, lines 34-63).

***Allowable Subject Matter***


7. Claims 2,5,6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M. Lee whose telephone number is (571) 272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LML   
08/27/2007

  
BOYER D. ASHLEY  
SUPERVISORY PATENT EXAMINER